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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,417	06/08/2000	Arthur R. Tilford	PD-990142	9701

20991 7590 10/01/2003

HUGHES ELECTRONICS CORPORATION
PATENT DOCKET ADMINISTRATION RE/R11A109
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EXAMINER

BELIVEAU, SCOTT E

ART UNIT	PAPER NUMBER
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2614

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DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/590,417	TILFORD, ARTHUR R.	
	Examiner	Art Unit	
	Scott Beliveau	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 21 May 2003 was filed after the mailing date of the Non-Final Rejection on 23 April 2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

2. The substitute drawings were received on 25 August 2003 in order to illustrate claimed subject matter. These drawings are approved with respect to the previously raised objections.
3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed scenarios involving the interaction between a "handheld computing device" with multiple "set top boxes" that are "different" as well as the claimed scenario involving the interaction between a "set top box" and multiple "handheld computing devices" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. Claim 33 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described

in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the examiner is unclear as to where support may be found describing the scenario whereby a “first” and a “second handheld computing device” may interact with a “set top box” wherein the “first” and “second handheld computing devices” are “different”. The disclosure suggests that a single “handheld computing device” is operable with multiple set top boxes (Page 14, Lines 26-28), however, as aforementioned it is unclear as to where support is found for multiple “handheld computing devices” being operable to interact with a single set top box.

Response to Arguments

5. The OFFICIAL NOTICE presented in the previous action stating that it is notoriously well known in the art to for a VCR to “transmit the audio/visual information . . . in response to the depressing of a signal button” such as the play button was not traversed and is accordingly taken as an admission of the fact noted.
6. Applicant’s arguments/amendment, with respect to the rejection under Wharton et al. of claims 1, 12, and 21 and its dependencies have been fully considered and are persuasive. The rejection of claims 1-3, 8-10, 12-13, 18-19, 21-23, and 28-29 under Wharton et al. has been withdrawn. In particular applicant’s comments/amendments to claims 1, 12, and 21, such that the information received from the handheld computing device is subsequently provided to an output device associated with the “second set top box” is persuasive.

7. Applicant's arguments filed 25 August 2003 have been fully considered but they are not persuasive with respect to the rejection under Perlman in view of the PocketTV™ article.

With respect to the applicant's remarks pertaining to the combined teachings of the Perlman and PocketTV™ article, the examiner notes that the usage of the PocketTV™ article optionally relied. The applicant's remarks are non-responsive with respect to the grounds of rejection under the single Perlman reference. The examiner rejected claims 1-2, 12, and 21-22 based on the use of the Perlman VCR as a "handheld computing device". The claims were not limiting with respect to the nature of the "handheld computing device" such that it was necessarily embodied within a PDA or similar device. No comments were provided by the applicant to traverse the rejection using the single Perlman reference.

With respect to applicant's remarks pertaining to the combined teachings, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Perlman reference discloses that a VCR [130] is operable to "store" the "audio/video information" from any of the connected sources and to subsequently "transmit" the stored material to the "set top box" [40] for display on an "output device" [110] (Col 9, Lines 58-61). The Perlman et al. reference does not explicitly disclose or preclude that the VCR is necessarily a "handheld computing device" such as PDA. As noted by the applicant, the PocketTV™ article clearly equates the PocketTV™ with a VCR thereby creating the suggestion to one of ordinary skill in the art as to the existence of a "handheld computing device" that is also a VCR and advantageously portable. The "HP Jornada 430se" platform referenced by the article

inherently supports the ability to both transmit and receive data to/from the device (HP Jornada: User Guide – Page 8). This transmission may be to a “computer” such as that of Perlman (Col 6, Lines 49-60). Furthermore, the Perlman reference suggests that the “set top box” [40] is operable to interconnect any consumer electronic device (Col 6, Lines 43-60). Accordingly, when taken in combination the combined reference disclose a hypothetical embodiment wherein a “handheld computing device” may interconnect with a set-top-box to receive/record media and may further playback this media either through an output device such as a television set while locally connected or through an on-screen display if the user would like to watch the recorded movie on the road.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman (US Pat No. 6,169,879), in view of the PocketTV™ article.

In consideration of claims 1-2, and 21-22, the Perlman et al. reference discloses a method, system, and article of manufacture for facilitating communications between a “set top box” [40] and a VCR [130]. As there is no explicit recitation that the “first” and “second set top box” are the different, the examiner shall presume that they are the same for all dependent claims, as recited claim 2 and 22. The reference discloses that the “set top box”

[40] is operable to “receive” and “transmit audio/video information” from/to any of the connected sources including a VCR [130] (Col 9, Lines 23-30, 46-49). The reference further teaches that the VCR [130] is operable to “store” the “audio/video information” from any of the connected sources and to subsequently “transmit” the stored material to the “set top box” [40] for display on an “output device” [110] (Col 9, Lines 58-61).

The reference, however, does not explicitly disclose nor preclude that the aforementioned VCR [130] may not be a “hand held computing device having a memory” as embodied by a PDA. It is arguable that the VCR [130] may be broadly construed as being a hand held computing device, in so far as it is feasible that at some point in time it may be “hand held” while being carried or moved. Assuming arguendo, the Perlman reference suggests that the “set top box” [40] is operable to interconnect any consumer electronic device (Col 6, Lines 43-60). The “PocketTV Brings Video to Palm-size PC” article explicitly discloses that with their software a “handheld or Palm-size PC becomes a miniature VCR”. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a “hand held computing device having a memory” as a VCR as disclosed in the PocketTV™ article in conjunction with the “set top box” [40]/VCR [130] interconnection teachings of Perlman for the purposes of enabling the recording/storage of “audio/visual information” on a device that may advantageously allow for the storage of an entire movie in your pocket (PocketTV™ article).

Claims 12 and 32 are rejected as aforementioned in the rejection of claims 1-2, and 21-22 wherein the “first” and “second handheld computing device” is the “same”.

In consideration of claims 3, 13, and 23, it is notoriously well known in the art to for a VCR to “transmit the audio/visual information . . . in response to the depressing of a signal button” such as the play button. As aforementioned, the Perlman reference discloses that the VCR [130] is operable to “transmit the audio/visual information” to a “set top box” [40]. Accordingly, given that the suggestion by PocketTV™ article that the PocketTV™ is a “miniature VCR”, it would have been obvious to one of ordinary skill in the art at the time of the invention that it would have a “play button” similar to other VCRs in the art for the purpose of providing a means for “transmitting audio/visual information” through an interface with which a user of a VCR is familiar.

Claims 4-6, 14-16, and 24-26 are rejected wherein the PocketTV™ article discloses that it is operable to record MPEG based movies. It is well known in the art that a movie such as “The Godfather” may be construed as an “electronic version of a book” which comprises both “audio recordings” and “video clips”.

Claims 7, 17, and 27 are rejected wherein the Perlman reference suggests that the VCR [130] is operable to record a “video game” [164] (Col 9, Lines 58-61).

Claims 8, 18, and 28 are rejected wherein the audio/visual information may be displayed on a “television” [110].

Claim 9 is rejected wherein the PocketTV™ article discloses that the software enables a user to “display the audio/visual information on the hand held computing device”.

Claims 10, 19, and 29 are rejected wherein the Perlman reference suggests that “audio/visual information” may be in an “encrypted form” that is subsequently routed to a “cable box” [122] for “decryption” (Col 10, Lines 50-67). It would have been obvious to one

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of ordinary skill in the art to modify the “set top box” [40] of Perlman to incorporate the “decryption” functionality of the “cable box” [122] as is known in the art for the purposes of simplifying the operation/interconnection of the system thereby allowing the “set top box” [40] to tune to both scrambled and non-scrambled channels without the need to reroute the signals. Assuming arguendo, the limitation may be met wherein the “first set top box” is the “cable box” [122], and the “second set top box” is the “central electronics device [40].

Claims 11, 20, and 30 are rejected wherein the “transmitting of the audio/visual information” is controlled through a “graphical user interface” such as an EPG displayed on the “output device” [110] (Col 8, Lines 15-21; Col 12, Lines 14-36).

Claims 31 and 34 are rejected based on a reinterpretation of claims 1 and 21. In consideration 31 and 34, the Perlman reference method and article of manufacture for facilitating communications between a “first set top box” [122], a “second set top box” [40], and a “handheld computing device” or VCR [130]. The reference discloses that the “first set top box” [122] is operable to “receive” and “transmit audio/video information” via the “second set top box” [122] from/to any of the connected sources including a VCR [130] (Col 9, Lines 23-30, 46-49; Col 10, Lines 50-67). The reference further teaches that the VCR [130] is operable to “store” the “audio/video information” from any of the connected sources and to subsequently “transmit” the stored material to the “second set top box” [40] for display on an “output device” [110] (Col 9, Lines 58-61).

The reference, however, does not explicitly disclose nor preclude that the aforementioned VCR [130] may not be a “hand held computing device having a memory” as embodied by a PDA. It is arguable that the VCR [130] may be broadly construed as being a hand held

computing device, in so far as it is feasible that at some point in time it may be “hand held” while being carried or moved. Assuming arguendo, the Perlman reference suggests that the “second set top box” [40] is operable to interconnect any consumer electronic device (Col 6, Lines 43-60). The “PocketTV Brings Video to Palm-size PC” article explicitly discloses that with their software a “handheld or Palm-size PC becomes a miniature VCR”.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a “hand held computing device having a memory” as a VCR as disclosed in the PocketTV™ article in conjunction with the “set top box” [40/122] /VCR [130] interconnection teachings of Perlman for the purposes of enabling the recording/storage of “audio/visual information” on a device that may advantageously allow for the storage of an entire movie in your pocket (PocketTV™ article).

In consideration of claim 33, as aforementioned, the Perlman or combined Perlman and PocketTV™ references discloses a method for interconnecting a plurality of consumer electronic devices. The Perlman reference, does not explicitly disclose nor preclude the use of multiple VCR [130] based “handheld computing devices” to be interconnected to the system. It is well known in the art for consumers to interconnect multiple VCRs so as to enable the simultaneous recording of one program and playback of another. Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to employ a “first” and a “second handheld computing device” in conjunction with the Perlman reference for the purpose of advantageously providing a user with the means to record one program while playing back another.

Alternatively, it is well known in the art that viewers desire to share recorded media. The combined Perlman and PocketTV™ articles suggest the use of a portable “handheld computing device” in which a viewer may take recorded media along with them. One of ordinary skill in the art would recognize that multiple home entertainment systems of the combined references may exist and meet the claimed limitations wherein the “first” and “second handheld computing devices” are “different”. Feasibly a viewer with a “first hand held computing device” may “receive audio/visual information” that is “transmitted” to a “first handheld computing device” and “stored”. The viewer’s friend may own a “second handheld computing device” that “receives” and “stores” a different program. Over afternoon tea, the second viewer may talk about the program that he/she watched last night. Presuming that the first viewer has not viewed the program, the second viewer having ordinary skill in the art and being a polite conversationalist may offer to share the contents of the “second handheld computing device”. One having ordinary skill in the art would subsequently recognize that it would be advantageous to plug the “second handheld computing device” into the first users home entertainment system such that it “receives” and “provides the audio/visual information from the second hand held computing device” to an “output device” [110] such as a television set for the purpose of advantageously providing the video display on a larger screen that is easier to view.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of

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claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Dureau et al. (US Pub No. 2002/0056112) reference discloses a home digital assistant that enables a user to obtain information from and to interact with the interactive television system.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 8:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone numbers for the

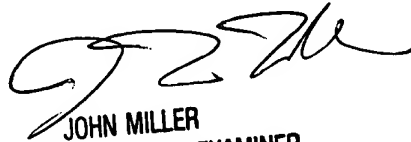
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organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

SEB

September 22, 2003


JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600